

### REMARKS

The December 11, 2007 Official Action has been carefully reviewed. In view of the amendments submitted herewith and the following remarks, favorable reconsideration and allowance of this application are respectfully requested.

At the outset it is noted that a shortened statutory response period of three (3) months was set forth in the December 11, 2007 Official Action. Therefore, the initial due date for response was March 11,, 2007. Accordingly, a petition for a 3 month extension of time is presented with this response, which is being filed within the three month extension period.

Claims 5-9 and 11 have been rejected for allegedly failing to satisfy the written description requirement of 35 U.S.C. §112, first paragraph. The Examiner contends that the amendment presented on 6 February 2008 introduced new matter into the application.

Claims 5 and 10-11 have been further rejected for allegedly failing to satisfy the written description requirement of 35 U.S.C. §112, first paragraph.

At page 5 of the Official Action, the Examiner has rejected claims 5 and 9-11 as allegedly lacking enablement.

Lastly, the Examiner has objected to claims 6-9 for being dependent on a rejected base claim but indicates the claims would be allowable if rewritten in independent form including all the limitations of the rejected base claim and any intervening claims.

The foregoing objection and rejections constitute all of the grounds set forth in the December 11, 2007 Official Action for refusing the present application.

In accordance with the instant amendment, claim 5 has been amended. Support for the amendment to claim 5 can be found, for example, in claims 10 and 11 as previously presented, Examples I and IV, and Figure 5. No new matter has been introduced into this application by reason of any of the amendments presented herewith.

In view of the present amendment and the reasons set forth in this response, Applicants respectfully submit that the objection to claims 6-9; and the 35 U.S.C. §112, first paragraph rejections of claims 5 and 9-11, as set forth in the December 11, 2007 Official Action, cannot be maintained. These grounds of objection and rejection are, therefore, respectfully traversed.

**CLAIMS 5 AND 9-11, AS AMENDED, SATISFY THE WRITTEN DESCRIPTION AND ENABLEMENT REQUIREMENTS OF 35 U.S.C. §112, FIRST PARAGRAPH**

Claims 5-9 and 11 have been rejected for allegedly failing to satisfy the written description requirement of 35 U.S.C. §112, first paragraph. This is a new matter rejection. Specifically, the Examiner contends that the specification fails to provide support for each of the NEP and PEP promoters recited in claim 5 as amended in Applicant's previous response. While not acquiescing to the Examiner's position, claim 5 has been further amended to recite those NEP and PEP promoters which the Examiner has indicated are supported by the specification as filed. See page 3, ¶4 of the Official Action. Specifically, claim 5 has been amended to omit recitation of 1) an atpB NEP promoter from tobacco; 2) a rpoB NEP promoter from tobacco or barley; and 3) an clpP NEP promoter from tobacco or barley. The claim has been further amended to specify that the PEP promoters recited are either Prnn or clpP from rice. As above, the Examiner acknowledges that this subject matter is supported by Example IV. See page 3, ¶6 and page 5, ¶5 of the Official Action. It is respectfully submitted that the foregoing amendment removes any perceived new matter from claim 5 and 10-11. Accordingly, the rejection has been rendered moot and should be withdrawn.

At page 3 of the Official Action, the Examiner has further rejected claims 5 and 10-11 as failing to comply with the written description requirement. Specifically, it is the Examiner's position that the specification fails to provide the structural and functional characteristics of each of the

NEP and PEP promoters encompassed by the claims. As stated above, claim 5 has been amended to recite the NEPs and PEPs provided in the specification. Accordingly, the claims, as amended, fully comply with the written description requirements of the statute. Thus, the rejection on this grounds should also be withdrawn.

Finally, claims 5 and 9-11 have been rejected for allegedly failing to satisfy the enablement requirement of 35 U.S.C. §112, first paragraph. It is the Examiner's position that the specification 1) fails to provide adequate written description for the NEP and PEP promoters in claims 10 and 11, respectively, from any species of plant, 2) fails to adequately describe the structural and functional characteristics of the full breadth of PEP and NEP promoters recited in claims 5, 10, and 11, and 3) fails to fully enable a skilled artisan to practice the instantly claimed invention over the entire breadth of PEP and NEP promoters claimed.

Applicants respectfully disagree with the Examiner's position for all of the reasons of record. However, in the sole interest of expediting prosecution of the instant application, Applicants have amended claim 5, from which claims 9-11 depend, to recite that the *clpP*, *rpoB*, and *atpP* NEP promoters are from the plant species identified in Example 1 and Figure 5.

With regard to the PEP promoters, the Examiner states that only the rice *clpP* PEP promoter is fully enabled. Applicants respectfully disagree and submit that *Prnn* PEP promoter is also fully enabled by the disclosure in the application.

In light of all of the foregoing, Applicants respectfully submit that the rejections of claim 5 and 9-11 under 35 U.S.C. §112, first paragraph are untenable and respectfully request their withdrawal.


### CONCLUSION

It is respectfully requested that the amendments presented herewith be entered in this application, since the amendments are primarily formal, rather than substantive in nature. This amendment is believed to clearly place the pending claims in condition for allowance. In any event, the claims as presently amended are believed to eliminate certain issues and better define other issues which would be raised on appeal, should an appeal be necessary in this case.

In view of the amendments presented herewith, and the foregoing remarks, it is respectfully urged that the rejections set forth in the December 11, 2007 Official Action be withdrawn and that this application be passed to issue.

In the event the Examiner is not persuaded as to the allowability of any claim, and it appears that any outstanding issues may be resolved through a telephone interview, the Examiner is requested to call the undersigned at the phone number given below.

Respectfully submitted,  
DANN, DORFMAN, HERRELL AND SKILLMAN  
A Professional Corporation

By   
Kathleen D. Rigaut, Ph.D., J.D.  
PTO Registration No. 43,047

Telephone: (215) 563-4100  
Facsimile: (215) 563-4044